Supreme Court, U.S.
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No. 89-1866

IN THE
Supreme Court of the United States
OCTOBER TERM, 1989

FRANKLIN PIERCE LAW CENTER,
Petitioner,

v.

GEORGETOWN UNIVERSITY,
Respondent.

On Petition for a Writ of Certiorari to the United States Court of Appeals for the Federal Circuit

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BRIEF IN OPPOSITION

SCOTT BLAKE HARRIS
Counsel of Record
DANIELA WINKLER
CHRISTOPHER C. KEARNEY
WILLIAMS & CONNOLLY
839 17th Street, N.W.
Washington, D.C. 20006
(202) 331-5000
Counsel for Respondent Georgetown University

WILSON - EPES PRINTING CO., INC. - 789-0096 - WASHINGTON, D.C. 20001

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QUESTION PRESENTED

1. Whether the United States Court of Appeals for the Federal Circuit erred in affirming the factual determination that there is insufficient evidence of secondary meaning in the record to permit trademark registration of petitioner's admittedly descriptive mark.

RULE 29.1 STATEMENT

Respondent Georgetown University is a District of Columbia not for profit corporation. It has no parents or non-wholly owned subsidiaries, except that it is one of two members of a District of Columbia not for profit corporation named the Fidia-Georgetown Institute for Neurosciences, Inc.

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On Petition for a Writ of Certiorari to the United States Court of Appeals for the Federal Circuit

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BRIEF IN OPPOSITION

STATEMENT OF THE CASE

Franklin Pierce Law Center ("Franklin Pierce") petitions this Honorable Court to review the per curiam decision of the United States Court of Appeals for the Federal Circuit ("the Federal Circuit") affirming a unanimous decision by the Trademark Trial and Appeal Board ("the Board") sustaining the opposition of Georgetown University ("Georgetown") to a proposed trademark registration. Georgetown, whose law students publish a journal entitled "The Journal of Law and Technology," challenged Franklin Pierce's proposed trademark registration of the name "The Journal of Law and Technology," the current subtitle of Franklin Pierce's journal "IDEA." Georgetown argued, and the Board agreed,

that the subtitle "The Journal of Law and Technology" is unregistrable as a trademark because it is a generic name for Franklin Pierce's publication, and generic names never qualify for trademark protection. The Board further held that, even if the proposed mark were not generic, it would still be unregistrable because, as an admittedly descriptive mark, it is protectable only if it had acquired distinctiveness, or secondary meaning, and the evidence demonstrated that it had not done so.

In an exceedingly brief per curiam opinion, the Federal Circuit affirmed the unanimous decision of the Board. The Federal Circuit's one paragraph opinion summarily repeated the Board's rejection of the evidence of secondary meaning submitted by Franklin Pierce.[1] The straightforward nature of the issues presented for review is underscored by the fact that the Federal Circuit's opinion was not published "because it does not add significantly to the body of law and is not of widespread legal interest." (A. 1a).

The factual background of this case is as follows. Franklin Pierce has been the publisher of the journal "IDEA" since 1973, when it acquired the PTC Research Foundation from George Washington University and, along with it, the right to publish a legal periodical called "IDEA", which carried the subtitle "The Patent, Trademark and Copyright Journal of Research and Education." (A. 5a).

When Franklin Pierce began publishing the journal, it continued to use the title "IDEA", but changed the subtitle to "The PTC Journal of Research and Education." Franklin Pierce again changed the subtitle in 1976, when it began using the current subtitle, "The Journal of Law and Technology." (A. 5a). It is for this latest variation

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[1] The Federal Circuit, while affirming the Board's holding unqualifiedly, discussed only the issue of secondary meaning in its brief opinion and not the issue of genericness.

of the subtitle of "IDEA" that Franklin Pierce sought trademark protection.

Franklin Pierce adopted this third subtitle to describe the coverage of its journal "IDEA". Franklin Pierce's President, Robert Rines, testified that Franklin Pierce began using the subtitle "The Journal of Law and Technology" to reflect the fact that Franklin Pierce was expanding its focus of study into areas of "the interfaces between law and technology" and to establish its identity as "the pioneer law school" in this area. (A. 6a). In the spring of 1986, Georgetown first published a journal with the title "The Journal of Law and Technology". Harvard University had established (but not yet published as of the Board's opinion) a publication called "The Harvard Journal of Law and Technology". (A. 5a).

Franklin Pierce filed a trademark registration application for the name "The Journal of Law and Technology" in March 1986. (A. 3a). But in May 1986 that application was rejected because, in the Patent and Trademark Office's view, this subtitle merely described the subject matter of Franklin Pierce's journal. As the refusal stated:

> Registration is refused on the Principal Register under Section 2(e)(1) of the Trademark Act on the ground that the designation sought to be registered merely describes the subject matter of the applicant's goods. *Applicant's goods are journals concerning the fields of law and technology, and, as such, the title of the journal merely describes the primary subject matter of the goods.*

(A. 15a) (emphasis added).

In response to this rejection, Franklin Pierce amended its trademark application to seek registration under Section 2(f) of the Lanham Act, 15 U.S.C. § 1052(f) (1988). (A. 3a, 5a). That amended application acknowledged that the mark was descriptive, (A. 5a), but sought registration because the mark had acquired sec-

ondary meaning. The Patent and Trademark Office subsequently published Franklin Pierce's proposed mark for opposition. Georgetown filed a timely opposition to the proposed registration, thereby initiating the proceedings below. (A. 4a).

REASONS FOR DENYING THE WRIT

The only issue addressed in the opinion of the Federal Circuit in this case was the factual issue whether Franklin Pierce's proposed trademark, which was admittedly descriptive, had acquired secondary meaning, and therefore was eligible for federal trademark registration. Franklin Pierce attempts to convert this issue into one appropriate for the grant of a Writ of Certiorari by erroneously asserting that "hopeless confusion" exists among United States Courts of Appeal on "issues of fundamental importance in trademark and unfair competition law." Petition for Writ of Certiorari to the United States Court of Appeals for the Federal Circuit ("Petition") at 7-8. Yet the only confusion that exists is that created by petitioner as a result of its misreading of the opinions below and its misinterpretation of a fundamental and essentially unquestioned tenet of trademark law: a descriptive mark (one that is not fanciful or suggestive but merely describes a product or service) is not subject to trademark registration and protection unless there is sufficient evidence of acquired distinctiveness, or secondary meaning—i.e. evidence that consumers associate the mark at issue with the registrant's product alone. *See, e.g., Carter-Wallace, Inc.* v. *Procter & Gamble Co.*, 434 F.2d 794, 802 (9th Cir. 1970).[2]

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[2] Although the Federal Circuit opinion discussed only the issue of secondary meaning, its decision affirmed the Board's holding unqualifiedly. There is no basis for Franklin Pierce's naked assertion that the Federal Circuit "[t]acitly reject[ed] the holding of the [Board] that the mark is inherently unregistrable as *generic*. . . ." Petition at 7.

The questions presented by petitioner for review, which are by no means a model of clarity, appear to be based on the following contentions: that the Federal Circuit erred by requiring a scientifically accurate survey to establish secondary meaning; that there is a conflict among the Circuits whether an admittedly descriptive mark is entitled to trademark protection in the absence of a showing of secondary meaning; and that Section 2(f) of the Lanham Act somehow abrogates the common law requirement of secondary meaning for descriptive marks. Each of these contentions is without foundation.

I. THE CIRCUIT COURT DID NOT HOLD THAT A SCIENTIFICALLY ACCURATE SURVEY IS NECESSARY TO ESTABLISH SECONDARY MEANING

Petitioner tries to create the erroneous impression that the Federal Circuit affirmed the Board's decision to sustain Georgetown's opposition *solely* because Franklin Pierce failed to present a scientific survey establishing the secondary meaning of its purported mark, *see* Petition at 7, and that by virtue of this holding the Federal Circuit is wholly out of line with opinions of other United States Courts of Appeal concerning the necessity of such survey evidence. *Id.* at 11-12. In so doing, petitioner grossly distorts the decision of the Federal Circuit and attempts to create a conflict among the United States Courts of Appeal where none exists.

It is true that neither the Board nor the Federal Circuit gave much weight to ten letters from subscribers that were submitted by Franklin Pierce in support of its claim of secondary meaning. (A. 2a, 9a-10a). It is also true that the Board succinctly stated that this evidence was not a scientifically accurate survey. (A. 10a). Not surprisingly, the Federal Circuit agreed. (A. 2a). Neither the Board nor the Federal Circuit, however, even remotely suggested that a scientific survey is a *prerequisite* to a finding of secondary meaning. The finding of

the Board that the evidence presented by Franklin Pierce did not establish secondary meaning was not based on the lack of any acceptable survey evidence, but rather on the absence of adequate evidence of *any* kind.

The only additional evidence submitted by Franklin Pierce in an attempt to establish secondary meaning was as follows:

1. Use of the words as either part of the title or the subtitle on covers of applicant's journal since 1976;
2. The expenditure of $600,000 by Franklin Pierce on the journal as a whole since 1976;
3. Invoices and correspondence showing Franklin Pierce, as well as others, referring to applicant's journal using the words sought to be registered.

(A. 8a). The Board carefully considered each of these items and concluded that the evidence presented did not establish secondary meaning. (A. 8a-10a).

Thus, the position taken both by the Board and by the Federal Circuit is completely in line with the position taken by other courts, including those cited by petitioner, that have held that survey evidence is but one form of evidence of secondary meaning and that other evidence may suffice. *See, e.g., Centaur Communications, Ltd.* v. *A/S/M Communications, Inc.*, 830 F.2d 1217, 1223 (2d Cir. 1987); *International Kennel Club, Inc.* v. *Mighty Star, Inc.*, 846 F.2d 1079, 1086 (7th Cir. 1988); *Yamaha Int'l Corp.* v. *Hoshino Gakki Co.*, 840 F.2d 1572, 1583 (Fed. Cir. 1988).[3] Indeed, other than its misreadings of

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[3] Indeed, even if petitioner's misreading of the Federal Circuit's opinion were correct, the resulting conflict would be one within the Federal Circuit rather than one between different United States Courts of Appeal. It is well recognized that the appropriate vehicle for resolving a split within a circuit is rehearing *en banc*. Petitioner's request for such a rehearing was, not surprisingly, denied.

the opinions below in this case, petitioner does not point to any authority to the contrary. The only issue was a purely factual one—whether petitioner presented sufficient evidence to establish secondary meaning. This factual issue was carefully considered both by the Board and by the Federal Circuit, and is not appropriate for review by this Court.

II. THERE IS NO CONFLICT AMONG THE CIRCUITS WHETHER A PARTY SEEKING REGISTRATION OF AN ADMITTEDLY DESCRIPTIVE MARK MUST PROVIDE EVIDENCE OF SECONDARY MEANING

Both the Board and Federal Circuit held that Franklin Pierce was not entitled to trademark registration because of the factual finding that it had not presented sufficient evidence to establish secondary meaning with respect to its admittedly descriptive mark. As the Federal Circuit noted:

> To have held that the descriptive words [journal of law and technology] have a distinctiveness for the applicant's product would have required that there be strong proof of a secondary meaning.

(A. 2a). Contrary to petitioner's assertion, there is no conflict among the United States Courts of Appeal whether there must be evidence of distinctiveness, or secondary meaning, before a descriptive mark may be subject to federal trademark protection. Petitioner's claim that such a conflict exists is based on no more than an erroneous reading of the very case law it cites as an exception to the rule.

Franklin Pierce points to case law from the Second, Fifth and Seventh Circuits that supposedly holds that descriptive marks are entitled to trademark protection without a showing of secondary meaning. The law in these Circuits, petitioner alleges, stands as an exception to and in conflict with the law in the other Circuits, which requires such a showing. To the contrary, how-

ever, each of these Circuits agrees that secondary meaning is a prerequisite to obtaining federal trademark protection for a descriptive mark.[4]

Petitioner first points to a number of decisions from the Second Circuit which it claims abrogate the requirement of showing secondary meaning before a descriptive mark is entitled to trademark protection. All these decisions, however, make clear that the secondary meaning requirement is abrogated *only if* the claim at issue is one of deliberate palming off or deliberately unfair business practices. *See Harlequin Enters. Ltd.* v. *Gulf & Western Corp.*, 644 F.2d 946 (2d Cir. 1981); *Flexitized, Inc.* v. *National Flexitized Corp.*, 335 F.2d 774 (2d Cir. 1964), *cert. denied*, 380 U.S. 913 (1965); *Lincoln Restaurant Corp.* v. *Wolfies Rest. Inc.*, 291 F.2d 302 (2d Cir.), *cert. denied*, 368 U.S. 889 (1961).[5] No

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[4] The Circuits have unanimously acknowledged the secondary meaning requirement. *See, e.g., Purolator, Inc.* v. *EFRA Distribs. Inc.*, 687 F.2d 554, 562 (1st Cir. 1982); *A.J. Canfield Co.* v. *Honickman*, 808 F.2d 291, 297 (3rd Cir. 1986); *Pizzeria Uno Corp.* v. *Temple*, 747 F.2d 1522, 1527 (4th Cir. 1984); *Burke-Parsons-Bowlby Corp.* v. *Appalachian Log Homes, Inc.*, 871 F.2d 590, 594 (6th Cir. 1989); *Co-Rect Prods., Inc.* v. *Marvy! Advertising Photography, Inc.*, 780 F.2d 1324, 1329 (8th Cir. 1985); *Marker Int'l* v. *DeBruler*, 844 F.2d 763, 764 (10th Cir. 1988); *American Television & Communications Corp.* v. *American Communications and Television, Inc.*, 810 F.2d 1546, 1548 (11th Cir. 1987); *Blinded Veterans Assn* v. *Blinded American Veterans Found*, 872 F.2d 1035, 1040 (D.C. Cir. 1989). *See also supra* at 4.

[5] Permitting a plaintiff to prevail on an intentional palming off or unfair competition claim without a showing of secondary meaning is precisely the "New York Rule" recited in 1 *McCarthy, Trademarks and Unfair Competition* 669 (2d ed. 1984). Petitioner offers a misleading and incomplete quotation from that treatise suggesting that the Second Circuit has abrogated the secondary meaning requirement altogether. *See* Petition at 8. A full and fair reading of McCarthy makes clear that the Second Circuit has abrogated the requirement of showing distinctiveness or secondary meaning *only* where "certain types of unfair practices may call for judicial remedies even though traditional secondary meaning and likelihood of confusion are not proven." *Id.*

such claim is at issue here. In fact, the most recent Second Circuit opinion petitioner cites explicitly reaffirms the secondary meaning requirement for trademark protection. In *Yarmuth-Dion, Inc.* v. *D'ion Furs, Inc.*, 835 F.2d 695, 702 (5th Cir. Unit A Oct. 1981), *cert. denied,* cluded that "[a]s a descriptive mark, [a] name is protectable . . . only when it has acquired secondary meaning."

The two Fifth Circuit cases petitioner relies on concerned trade dress issues pursuant to a separate statutory provision, 15 U.S.C. § 1125(a). They nevertheless affirm, rather than abrogate, the secondary meaning requirement for trade dress or marks that are merely descriptive. In *Sicilia Di R. Biebow & Co.* v. *Cox*, 732 F.2d 417, 426 (5th Cir. 1984), the Fifth Circuit held, quoting the other Fifth Circuit case petitioner cites, *Chevron Chem Co.* v. *Voluntary Purchasing Groups, Inc.*, 659 F.2d 695, 702 (5th Cir. Unit A, Oct. 1981), *cert. denied,* 457 U.S. 1126 (1982), that proof of secondary meaning was not necessary because the trade dress in question was " 'sufficiently distinctive of itself to identify the producer.' " Moreover, it went on to state that, if the trade dress at issue was "descriptive", "a finding of secondary meaning would then be required." In any event, the court distinguished trade dress from a mark, observing that one

> purpose for the secondary meaning requirement is to preserve the limited number of words and designs that are useful in describing goods and services . . . . The need to avoid monopolization of a design lessens, however, in the area of distinctive trade dress. The wide range of available packaging and design options allows a producer to appropriate a distinctive identity without unduly hindering his competitors' ability to compete.

Id.

Petitioners reliance on two Seventh Circuit cases is mystifying, since these cases do not in any way abrogate

the secondary meaning requirement. In fact, they both explicitly reaffirm that a showing of secondary meaning is required before a descriptive mark is protectable. In *Roulo* v. *Russ Berrie & Co.*, 886 F.2d 931, 936 (7th Cir. 1989), *cert. denied*, 110 S.Ct. 1124 (1990), the Seventh Circuit affirmed the principle that, "[i]f [a] mark is not distinctive, a showing of secondary meaning is required." The statement quoted by petitioner—that "secondary meaning is not hearsay when the trade dress is distinctive"—merely restates this principle. Similarly, in *A.J. Canfield Co.* v. *Vess Beverages, Inc.*, 796 F.2d 903, 907 (7th Cir. 1986), the Seventh Circuit applied the secondary meaning requirement and concluded, in ruling on a motion for a preliminary injunction, that "[s]ufficient evidence was introduced . . . to conclude that [plaintiff] had a better than negligible chance of demonstrating secondary meaning."

Even if the cases cited by petitioner stood for the proposition Petitioner claims they do, they would nevertheless not afford any basis upon which this Court could or should grant petitioner's writ. This is an issue which could have been but was not raised below. Petitioner could have challenged the secondary meaning requirement either before the Board or the Federal Circuit, but chose not to. Only after the Federal Circuit issued its decision did Franklin Pierce (in a Petition for Rehearing) raise the argument that its mark could be entitled to trademark protection even without a showing of secondary meaning. The Supreme Court of the United States is a court of last resort, not first resort. The conflict petitioner attempts belatedly to manufacture cannot obscure the simple fact that Franklin Pierce simply tried below but failed to demonstrate the existence of secondary meaning.

III. SECTION 2(f) OF THE LANHAM ACT DOES NOT ABROGATE THE COMMON LAW REQUIREMENT OF SECONDARY MEANING FOR DESCRIPTIVE MARKS

Section 2(f) of the Lanham Act, 15 U.S.C. § 1052(f) (1988), is the statutory provision which concerns federal trademark registration of descriptive marks. It acknowledges that, to be registered, a descriptive mark must have acquired distinctiveness and it establishes that the Patents and Trademark Office

> *may accept* as prima facie evidence that the mark has become distinctive, as used on or in connection with the applicant's goods in commerce, proof of substantially exclusive and continuous use thereof as a mark by the applicant in commerce for . . . five years . . . (Emphasis added).

Petitioner argues that this statute, like the cited opinions from the Second, Fifth and Seventh Circuits, indicates that a descriptive mark is protectable even absent a showing of secondary meaning. Petition at 8. Yet petitioner misreads this statute just as it misreads the case law from those Circuits.

Section 2(f) incorporates, rather than abolishes, the common law on the issue of secondary meaning. It explicitly states that nothing in the Lanham Act "shall prevent the registration of a mark . . . which has become distinctive of the applicant's goods in commerce." It does not change or even affect the common law concerning secondary meaning. As the United States Court of Customs and Patent Appeals stated in *In Re Deister Concentrator Co.*, 289 F.2d 496, 501 (C.C.P.A. 1961), the Lanham Act "does not create trademarks". As it observed, "[t]here is nothing whatever in the section saying what *shall* be registered". *Id.* at 502. Accordingly, Section 2(f) leaves it to the discretion of the Board and the Courts to determine what proof is necessary to qualify

a mark for registration. *See, e.g., In re Owens-Corning Fiberglas Corp.*, 774 F.2d 1116, 1125 (Fed. Cir. 1985). As noted above, the law is well established that a party must demonstrate that an admittedly descriptive mark like "The Journal of Law and Technology" has acquired secondary meaning before it is protectable as a trademark. This factual demonstration was the issue before the Board and the Federal Circuit and has no place for review by this Court.

CONCLUSION

For all the reasons set forth above, Franklin Pierce's Petition for a Writ of Certiorari should be denied.

Respectfully submitted,

SCOTT BLAKE HARRIS
Counsel of Record
DANIELA WINKLER
CHRISTOPHER C. KEARNEY
WILLIAMS & CONNOLLY
839 17th Street, N.W.
Washington, D.C. 20006
(202) 331-5000
Counsel for Respondent
Georgetown University

APPENDIX

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Note: This opinion has not been prepared for publication in a printed volume because it does not add significantly to the body of law and is not of widespread legal interest. It is a public record. It is not citable as precedent. The decision will appear in tables published periodically.

UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

No. 89-1484

FRANKLIN PIERCE LAW CENTER,
Appellant,

v.

GEORGETOWN UNIVERSITY,
Appellee.

DECIDED: January 25, 1990

Before MARKEY, *Chief Judge*, BENNETT, *Senior Circuit Judge*, NIES, *Circuit Judge.*

PER CURIAM.

DECISION

This appeal by Franklin Pierce Law Center, a New Hampshire corporation, is from a unanimous decision of the United States Patent and Trademark Office Trademark Trial and Appeal Board (board), which sustained an opposition brought by Georgetown University (Georgetown) to Franklin Pierce's proposed registration of the

title "The Journal of Law and Technology," the current subtitle of its journal, IDEA. We *affirm* the board's holding.

OPINION

The board held no secondary meaning was established here. To have held that the descriptive words have a distinctiveness for the applicant's product would have required that there be strong proof of a secondary meaning. The applicant's evidence on this was that the words had been used as a subtitle for IDEA since 1976 and that much money had been spent on the journal since that date. Further, correspondence and invoices used the words sought to be registered and statements from 10 people attest to the fact that they are unaware of other journals using the name "The Journal of Law and Technology." The board could not find that this was sufficient proof of secondary meaning in this case. Its holding was that the words were only descriptive terminology explaining what type of publication IDEA was and that length of use did not prove secondary meaning here. As to expenditures, the proof fell short of showing promotion of the words in the title or that the words have lost their descriptive significance and have acquired any secondary meaning thereby. Evidence of promotional activity was sparse. References by the applicant and others in correspondence were held insufficient to establish secondary meaning for the words in light of their highly descriptive nature. Letters by 10 subscribers solicited by the applicant with an eye toward this proceeding were held not to establish a scientifically accurate survey.

Hearing:
December 7, 1988

T. Henderson
Paper No. 23

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

GEORGETOWN UNIVERSITY

v.

FRANKLIN PIERCE LAW CENTER, INCORPORATED

Opposition No. 76,021 to application Serial No. 586,218

Filed March 5, 1986

Williams & Connolly for Georgetown University.

Rines and Rines and Nelson H. Shapiro and Ronald E. Shapiro for Franklin Pierce Law Center, Incorporated.

Before Rooney, Cissel and Quinn, Members.

Opinion by Cissel, Member:

Franklin Pierce Law Center, Inc., a New Hampshire corporation, applied to register "THE JOURNAL OF LAW AND TECHNOLOGY" on the Principal Register for "periodicals, namely journals whose contents deal with the interrelationship among science, innovation and legal systems." [1] The application is under the provisions of Section 2(f) of the Lanham Act. Applicant's

[1] S.N. 586,218, filed March 5, 1986.

claim of distinctiveness was accepted by the Examining Attorney based upon the affidavit of applicant's President, Robert Rines, who stated that as of July 1986, the words had been used exclusively and continuously for almost ten years by applicant as a trademark. No other support for the claim under Section 2(f) was either offered or requested.

Timely Notice of Opposition was filed by Georgetown University, a District of Columbia corporation. As grounds for the opposition opposer asserts that the mark of applicant is merely descriptive, that it is an "apt and common term" to describe applicant's goods and that opposer itself uses the same words to describe a publication of its own. Opposer asserts that the words sought to be registered are generic, but that even if they are held to be only merely descriptive of applicant's goods, applicant has failed to establish that they have acquired secondary meaning and indicate applicant as the source of the goods. Applicant's answer is basically a denial.

The record before us includes the testimony and associated exhibits of Robert Rines, applicant's President; Ellen Dixon-Law, editor-in-chief of the Harvard Journal of Law and Technology; and Howard Jacobsen, former managing editor of the Journal of Law and Technology published by Georgetown University. Additionally, made of record by opposer's Notice of Reliance are copies of pages from various volumes of applicant's journal and covers and pages from periodical indices.

Based on this record we find that the term "JOURNAL OF LAW AND TECHNOLOGY" is an apt descriptive name for applicant's publication, and that as such, it is unregistrable as a trademark for these goods. Moreover, even if it had not been shown to be a generic term for these goods, applicant has failed to establish that it functions to identify applicant's publication and distinguish it from other similar publications.

The record shows that in 1973 applicant acquired the PTC Research Foundation from George Washington University, including the right to publish a legal periodical called "IDEA" and subtitled the "Patent Trademark and Copyright Journal of Research and Education". When applicant began publication, applicant modified the subtitle to "The PTC Journal of Research and Education." Then, in 1976, applicant began use of the present terminology, 'The Journal of Law and Technology" along with "IDEA." The journal is referred to by applicant variously as "IDEA" or "IDEA THE JOURNAL OF LAW AND TECHNOLOGY," or as "THE JOURNAL OF LAW AND TECHNOLOGY."

In the spring of 1986, Opposer, Georgetown University, published a journal with the title "The Journal of Law and Technology... Harvard University has established a publication called "The Harvard Journal of Law and Technology", but although this publication has been organized and promoted, as of January 1988 the first issue had yet to be published.

There is no dispute as to the descriptiveness of the term sought to be registered. By making application under the provisions of Section 2(f) of the Act, applicant in effect concedes that the words are unregistrable under Section 2(e)(1) absent a showing of distinctiveness. Floss Aid Corp. v. John O. Butler Co., 205 USPQ 274 (TTAB 1979). At issue is the genericness of the term, and in the absence of proof that the term is generic, whether applicant has proved distinctiveness. A generic term can never be registered, even if there is evidence that it is associated with a single source. Miller Brewing Co. v. G. Heileman Brewing Co., 195 USPQ 281 (7th Cir. 1977), cert. denied, 434 U.S. 1025, 195 USPQ 591, (1978).

The case In re Marvin Ginn Corp. v. Int'l Assn. of Fire Chiefs, 228 USPQ 528, 532 (Fed. Cir. 1986) sets forth

a two-step inquiry for determining the genericness of a magazine title: "First, what is the class of publications or magazines at issue? Second, is the title understood by the relevant public to refer primarily to that class of magazines?" Both elements of this test are satisfied by the term sought to be registered in the case at hand.

The testimony of all three witnesses makes it quite clear that "Journal of Law and Technology" is simply an appropriate, apt descriptive name for a journal type of periodical which has as it subject the relationship between law and technology. Although applicant uses the words "science, innovation, and legal systems" in the application, the subject of the journal is described by applicant's president as "law and technology." (Rines' first deposition, p. 17: ". . . I thought this was a name that we ought to adopt as giving in the image, at the Franklin Pierce Law School, of the pioneer law school concerned with the interfaces between law and technology.") The witnesses on behalf of opposer as well as the Harvard Law School are equally clear that they selected the words "Journal of Law and Technology" to use in combination with their school names because the words name the kind of publication they produce, or, in the case of Harvard, intend to produce.

Whether or not Harvard has actually produced a publication using these words in the title is not determinative of the case at hand. The testimony relates to the perceived meaning of these words. Georgetown has actually used them on publications generically. Although Harvard has used them in a generic sense when funds and articles to be published have been solicited, the initial issue bearing the words "Journal of Law and Technology" has not been produced. The words "Journal of Law and Technology" are not more or less generic after actual use on this kind of publication than they are prior to such use.

In a case analogous to this one, CES Publishing Corp. v. St. Regis Publications, Inc., 531 F.2d 11, 188 USPQ 612 (2d Cir. 1975), the court held "Consumer Electronics Monthly" to be generic for that type of publication. The court reasoned that it was hard to think of a name which more accurately names a class of magazines than to simply take the name of the trade which is the subject of the magazine and add to it the term "monthly". Similarly, it is difficult to describe more accurately a journal which has as it subject the interface between law and technology than by adding the words "Law and Technology" to the word "Journal." In Conde Nast Publications, Inc. v. Redbook Publishing Co., 217 USPQ 356 (TTAB 1983), the Board held "The Magazine For Young Women" to be a generic designation for such a publication, even though it had been extensively used as the subtitle for applicant's magazine. The Board noted, p. 361, that if proprietary rights were recognized in the generic designation, other such publications "would be hampered in their free use of these highly descriptive words."

In the situation now before us, Georgetown, Harvard, other institutions, or for that matter, anyone else who wants to publish a journal on the subject of law and technology should be free to identify it using the ordinary terminology which would be understood by everyone interested in this emerging field to accurately name the kind or type of publication. Granting registration of the words "Journal of Law and Technology" to applicant or to anyone else would inhibit use by others of these generic words and therefore is not appropriate.

No amount or quality of evidence of distinctiveness can lead to registration of the common name of a thing. Miller Brewing, *supra;* Conde Nast, *supra.* If, however, the Board's holding that the term sought to be registered is a generic name for applicant's goods were to be reversed on appeal, our finding that applicant's evidence of

secondary meaning is inadequate to prove distinctiveness should be noted.

The evidence applicant contends shows that "Journal of Law and Technology" has become distinctive consists of the following: (1) use of the words as either part of the title or as the subtitle on covers of applicant's journal since 1976; (2) expenditure of $600,000 by applicant on the journal since 1976; (3) invoices and correspondence showing applicant as well as others referring to applicant's journal using the words sought to be registered; and (4) written statements from ten people to the effect that they know that applicant publishes its journal and that they are unaware of other journals using the name "Journal of Law and Technology."

As to the first point, merely using descriptive terminology, even widely using it over an extensive period, does not necessarily result in such terminology acquiring secondary meaning as an indicator of source. In this case, the evidence shows that the words sought to be registered have generally been used in a descriptive sense immediately following the primary title of the journal, "IDEA." Each cover bears the heading, "IDEA" in large block letters across almost the entire width of the booklet, with "The Journal of Law and Technology" appearing directly beneath it in letters less than a fifth the size of the letters which form the word "IDEA." This evidence does not support the proposition that the words sought to be registered are perceived as anything other than descriptive terminology explaining what type of publication "IDEA" is.

The expenditures in producing and promoting the journal hardly support the claim of distinctiveness for the words sought to be registered. There is no evidence of any extensive promotional activities, much less that the specific words of even the complete title, "IDEA THE JOURNAL OF LAW AND TECHNOLOGY," has been

widely promoted. This falls far short of proof that the final six words of the title have lost their descriptive significance and have acquired secondary meaning.

With regard to the third group of evidentiary materials submitted to show distinctiveness, the references by applicant and others to applicant's journal using only the words sought to be registered do not establish that the descriptive significance of the words has been lost. These materials show the words used in a shortened version of the title of the journal. For applicant to use them on invoices or for subscribers to use them in correspondence regarding the journal is not inconsistent with the retention of their descriptive significance. Indeed, calling the publication either "IDEA" or "THE JOURNAL OF LAW AND TECHNOLOGY" is less lengthy and less awkward than using the full title asserted by applicant, "IDEA THE JOURNAL OF LAW AND TECHNOLOGY", although there are examples of such use in the record. Evidence that a publisher or his customers correspond concerning the "LAW REVIEW" produced by the publisher would not establish that "LAW REVIEW" had become distinctive of the publication being so identified. Likewise, evidence that customers as well as the applicant in the case before us use the words, "THE JOURNAL OF LAW AND TECHNOLOGY" apart from "IDEA" to refer to applicant's journal does not establish secondary meaning for the words, especially in light of the highly descriptive nature of the words and their use by other to describe, rather than to identify, similar existing or planned publications.

The letters from subscribers similarly fail to establish secondary meaning for the words. These letters were admittedly solicited by applicant with an eye towards this proceeding. That these ten selected subscribers to the journal are familiar with its full title, "IDEA THE JOURNAL OF LAW AND TECHNOLOGY", and are unaware of anyone else using the last six words of it

does not prove that the descriptive significance of the words has been supplanted in the minds of a substantial portion of potential purchasers. This is not a scientifically accurate survey. Especially in light of the small number of people who offer their opinions in this way and the contrasting evidence that others have in fact used the same words descriptively in regard to their own publications, the letters from applicant's subscribers do not persuade us that distinctiveness has been attained by these words.

Applicant argues that other words are available to describe journals such as the one if produces, and that opposer has not met its burden of proof in that it failed to make a *prima facie* showing that the words that applicant seeks to register have not acquired distinctiveness.

The mere fact that other terms could also be used to name applicant's product does not prove that the name used by applicant is not generic. "To be held generic or a common descriptive name, it is not necessary that the designation be the only apt or common name of the goods . . ." (Conde Nast, *supra* at p. 360).

As to applicant's argument that opposer failed to meet its burden, the court in Yamaha International Corp. v. Hoshino Gakki Co., 840 F.2d 1572, 6 USPQ 2d 1001 (Fed. Cir. 1988) made it abundantly clear that an applicant has the ultimate burden of establishing the registrability of its mark. Because this matter is before us for a final decision on the merits based on a full record after a complete trial, rather than in the context of an interlocutory motion prior to development of a complete record, the sole issue for our determination is which party should prevail based on the entire record. The burdens of creating or rebutting *prima facie* showings are not relevant at this stage of this opposition proceeding.

In summary, these words applicant seeks to register are the common name of the goods on which they are used. As such, they are unregistrable under Section 2(e)(1) of the Act. Moreover, even if these words could somehow be determined to be only merely descriptive of the goods, rather than a generic name for them, applicant has failed to prove that they have acquired distinctiveness and serve to distinguish applicant's journals from those of others. Accordingly, registration under Section 2(f) of the Act is inappropriate. The opposition is sustained.

L. E. Rooney
R. F. Cissel
T. J. Quinn
Members, Trademark
Trial and Appeal Board

GJS
Paper No. 24

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

GEORGETOWN UNIVERSITY

v.

FRANKLIN PIERCE LAW CENTER, INCORPORATED

Opposition No. 76,021

Correction

Williams & Connolly for Georgetown University.

Rines and Rines for Franklin Pierce Law Center, Incorporated.

Before Rooney, Cissel and Quinn, Members.

Opinion by Cissel, Member:

The Board's decision of March 2, 1989 is amended as follows:

On page 1, line 12 is amended by deleting "Nelson H. Shapiro and Ronald E. Shapiro" as counsel for applicant.

Emma S. Brown
Administrator
Trademark Trial and
Appeal Board

ORDER

Before MARKEY, Chief Judge, NIES, Circuit Judge, and BENNETT, Senior Circuit Judge.

A petition for rehearing having been filed in this case,

UPON CONSIDERATION THEREOF, it is

ORDERED that the petition for rehearing be, and the same hereby is, denied.

The suggestion for rehearing in banc is under consideration.

The mandate will issue on March 2, 1990.

FOR THE COURT,

Dated: February 23, 1990

Francis X. Gindhart
Clerk

cc: NANCY RICHARDS-STOWER
DANIELA WINKLER

FRANKLIN PIERCE V GEORGETOWN UNIV, 89-1484 (PTO—76,021)

Note: This order has not been prepared for publication in a reporter.

U.S. DEPARTMENT OF COMMERCE—
Patent and Trademark Office

IN REPLY REFER TO THE FOLLOWING AND THE FILING DATE:

SERIAL NO.

[Illegible]

APPLICANT
PTC RESEARCH FOUNDATION

MARK

THE JOURNAL OF LAW AND TECHNOLOGY

ADDRESS

ROBERT H. RINES
RINES AND RINES
81 NORTH STATE STREET
CONCORD, NEW HAMPSHIRE 03301

ACTION NO.
01

MAILING DATE
05/15/86

Paper No.

ADDRESS:

Commissioner of Patents and Trademarks
Washington, D.C. 20231

The address of all correspondence not containing fee payments should include the word "Box 5."

AM PTO-1525 (2-84)
U.S. Dept. of Comm. Pat. & TM Office

Also furnish: (1) Serial number of application, (2) The mark, (3) Examining Attorney's name and Law Office number, (4) Mailing date of this action, and (5) Applicant's name (or applicant's attorney), telephone number and zip code.

A PROPER RESPONSE TO THIS OFFICE ACTION MUST BE RECEIVED WITHIN 6 MONTHS FROM THE DATE OF THIS ACTION IN ORDER TO AVOID ABANDONMENT.

Registration is refused on the Principal Register under Section 2(e)(1) of the Trademark Act on the ground that the designation sought to be registered merely describes the subject matter of applicant's goods. Applicant's goods are journals concerning the fields of law and technology, and, as such, the title of the journal merely describes the primary subject matter of the goods.

The Trademark Trial and Appeal Board and the Courts have consistently held marks which describe the subject matter of publications merely descriptive within the meaning of Section 2(e)(1) of the Act. *Trade Publications, v Big Bear of North Carolina, Inc.*, 191 USPQ 477 (M.D.N.C. 1976) (FOOD WORLD descriptive of magazine); *In re The Gracious Lady Service, Inc.*, 175 USPQ 380 (TTAB 1972) (*CREDIT CARD MARKETING* descriptive of periodic pamphlet); *Sterling House, Inc. v. Dell Publishing Co., Inc.*, 174 USPQ 299 (S.D.N.Y. 1972) (DAYTIME TV descriptive of a magazine); *In re Nippon Kokan Kabushiki Kaisha*, 171 USPQ 63 (TTAB 1971) (JAPAN STEEL NOTES descriptive of magazine); *Field Enterprises Educational Corporation v. Cove Industries Incorporated*, 161 USPQ 243 (E.D.N.Y.1969) (WORLD BOOK descriptive of encyclopedia); *In re Medical Digest, Inc.*, 148 USPQ 570 (TTAB 1965) (OB/GYN DIGEST descriptive of magazine); *Ex parte Motor Trend Publications Inc.*, 98 USPQ 26 (TTAB 1953) (MOTOR TREND descriptive of mag-

azines); *In re National Recreation Association, Inc.*, 85 USPQ 281 (CCPA 1950) THE PLAYGROUND descriptive of magazine); *McGraw-Hill Publishing Company, Inc. v. American Aviation Associates, Inc.*, 47 USPQ 494 (D.C. Cir. 1940) (AVIATION descriptive of magazine); *cf. Technical Publishing Company v. Lebhar-Friedman, Inc.*, 222 USPQ 839 (7th Cir. 1984) (SOFTWARE NEWS held generic for magazines); *Walker-Davis Publications, Inc. v. Penton/IPC, Inc.*, 211 USPQ 665 (E.D. Pa. 1981) (ENERGY MANAGEMENT generic as applied to publications); *Reese Publishing Company, Inc.* v. *Hampton International Communications, Inc.*, 205 USPQ 585 (2nd Cir. 1980) (VIDEO BUYER'S GUIDE so highly descriptive as to be incapable of functioning as a trademark for a publication); *CES Publishing Corp. v. St. Regis Publications, Inc.*, 188 USPQ 612 (2nd Cir. 1975) (CONSUMER ELECTRONICS generic as applied to publication); *In re World Library Publications, Inc.*, 198 USPQ 442 (TTAB 1978) (PEOPLE'S MASS BOOK generic as to hymn books); *Jenkins Publishing Co. v. Metalworking Publishing Co., Inc.*, 139 USPQ 346 (TTAB 1963) METALWORKING so highly descriptive as to be incapable of exclusive appropriation as applied to a publication).

In view of your long use of the mark, your attention is directed to Section 2(f) of the Trademark Act (15 U.S.C. 1052(f)). A proper claim of distinctiveness should state that you believe the mark has become distinctive as applied to the goods (or services) as a result of your substantially exclusive and continuous use in commerce (specifying the type of commerce) for the five years next preceding the filing date of this application. Such a claim must be supported by an affidavit or by a declaration (37 CFR Sections 2.20 and 2.41) signed by the applicant.

The term periodicals in the identification of goods is indefinite. Applicant may amend to periodicals, namely, journals . . . .

The term journal must be disclaimed as the generic name for applicant's goods.

You must insert a disclaimer of journal in the application. (See 15 U.S.C. 1056; TMEP section 904.06.)

A properly worded disclaimer should read as follows:

> No claim is made to the exclusive right to use journal, apart from the mark as shown.

According to my search of the Office registration records, there is no registered mark which so resembles the applicant's mark, when applied to the goods (or services), as to be likely to cause confusion, or to cause mistake, or to deceive. (15 U.S.C. 1052(d); TMEP section 1105.01.)

/s/ Mary C. Mack
MARY MACK
Trademark Attorney, Law Office I
703 557-3273

M:SW4

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